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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,019	11/28/2000	Daniel L. Cox	ACS-53509	3548

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/727,019	Applicant(s) COX, DANIEL L.	
	Examiner Suzette J Jackson	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 10-11 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment dated 4/2/04 has been received in application serial number 09/727,019.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7, 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanner et al. 5,868,755. Kanner et al. discloses the invention as claimed comprising: a catheter (**C**) including an elongated shaft having proximal and distal ends with an inner inflation lumen extending therein; an expandable member (**B**) with proximal and distal ends, a length and a desired inflated diameter disposed near the distal end of the elongated catheter shaft; a stent (**A**) mounted on the expandable member and a moveable sheath adapted to cover a portion of the stent during delivery with a inner lumen with smaller diameter than the desired inflated diameter of the expandable member; wherein the stent has a length which is smaller than the length of the expandable member (see figure 2); and the moveable sheath covers the entire stent

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during delivery (see col. 1, lines 43-63; col. 3, lines 12-65); The intended use recitation/functional language "*possessing sufficient strength to prevent any portion of the expandable member covered by the sheath from expanding when the expandable member is inflated*" carries no patentable weight in the absence of any distinguishing structure. Kanner et al. clearly discloses the structure as claimed and is found to be inherently capable of performing the function.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanner et al. in view of Fontaine et al. 6,447,540. Kanner et al. has been disclosed above however Kanner et al. does not specify a sheath with an inner lubricious coating to decrease friction between the sheath and the stent. Fontaine et al. teaches a stent deployment device that utilizes a thin lubricious inner sheath (76). It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the sheath of Kanner et al. and make the inner surface lubricious as taught by Fontaine

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et al. in order to reduce friction between the stent and the catheter and facilitate smooth longitudinal movement during deployment.

Allowable Subject Matter

7. Claims 4, 13-16 is allowed.

8. Claims 6 and 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 4/2/04 have been fully considered but they are not persuasive. It is noted that claims 6, 8-9 have been re-written into independent form, but they have not been canceled, therefore they remain objected claims. Applicant has amended the claims 1 and 7 with functional language. The device of Kanner et al. is capable of having sufficient strength to perform the claimed function. Kaner et al. also discloses in col. 4, lines 43-45 that the sheath is a rigid tube and this can possess sufficient strength. Applicant's current claims/structure are not distinguishable over the prior art of record.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

13. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

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14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in cursive script, appearing to read "Suzette J. Jackson", with a long horizontal flourish extending to the right.

Suzette J. Jackson
21 June 2004